UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,506	08/25/2003	Vijay Mital	MSFT-1949/301416.1	4218

41505 7590 04/03/2008

WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
LIU, LIN	
ART UNIT	PAPER NUMBER
2145	

MAIL DATE	DELIVERY MODE
04/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/648,506	MITAL ET AL.	
	Examiner	Art Unit	
	LIN LIU	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to communications filed on 01/15/2008. Claims 1- 23 are pending and have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot.

3. From applicant's remark, it appears to the examiner that there was miscommunication between the Applicant and the Applicant's representative, because from Applicant's remark, some of the questions and misunderstandings were already resolved and clarified during the telephonic interview with Applicant's representative Joseph F. Oriti. For example, on pages 8-9 of Applicant's Remark, Applicant argues that the assertion of figures 1-3 of Tracey's reference in mapping the preamble of the claim is misleading, and the Applicant does not understood how these figures are being interpreted with the corresponding limitation elements in the preamble. The examiner would like to address to the Applicant that such confusion was already addressed and clarified during the telephonic interview. The citing of the figures 1-3 of Tracey's reference in the preamble is just to give the Applicant a broad view of Tracey's reference and also to show that Tracy is in the same field of endeavor with Applicant's invention (Tracey: abstract, and background of invention), noted that Tracy's invention is also in the field of management of business application services, e.g. Debtor's application service.

4. Furthermore, in response to the arguments with regard to the figures cited in the preamble. The recitations in the preamble have not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

5. In response to Applicant's argument with regard to the confusion and misunderstanding of the prior art of record cited (e.g. Tracey and Brendle), it appears that the Applicant is misinterpreting the prior art of record by only citing a portion of the reference (e.g. Tracey: paragraphs 80, 100, 247). When reviewing a reference the applicants should remember that not only a specific portion of a reference but viewing *entire the reference as whole*. However, in order to move forward in prosecution and set a clear record of this application, Applicant is given another opportunity to response to the Office Action. The examiner has rejected the claims under the same ground of rejection with emphasis and explanation added to the claims.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims 1 and 10 in an attempt to overcome the 101 rejection by adding the new limitation: "storing an indication of a result of the step of determining", which is not presently supported by the specification, and applicant has not pointed out where in the specification support can be found for the limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims **1-6, 8-16, 18-19 and 21-23** are rejected under 35 U.S.C 102 (e) as being anticipated by **Tracey et al. (PGPUB: US 2003/0083917 A1).**

With respect to **claim 1,** Tracey teaches a method for determining if a plurality of actions are available to be performed in connection with a context

entity, the context entity being derived from a plurality of related service entities at a plurality of application services (Tracey: figures 1-3), the method comprising:

classifying actions (Tracey: fig. 6, page 4, paragraph 80, paragraph 6, paragraphs 89 & 95, and page 12, paragraph 187, noted the follow-up for the debtor's account and generating of debtor's daily report) for a plurality of service entities (Tracey: fig. 5, page 12, paragraph 193, noted the debtor's bin) at the plurality of application services (Tracey: page 4, paragraphs 79-80 and page 11, paragraphs 176-177, noted the application for collectors, debtors system and sales system), each action being classified according to its availability (Tracey: fig. 5, page 11, paragraph 117, noted the desk bins);

matching the related service entities based on their attributes (Tracey: page 13, paragraph 195, and table 1, noted the descriptions for each bin);

consolidating the related service entities into the context entity (Tracey: fig. 5, and page 12, paragraph 193, noted the debtor's related bins are grouped and organized in the desk bins); and

determining for each of the related service entities if an action is available to be performed on the service entity at a corresponding application service based on a corresponding classification of the availability of the action (Tracey: page 6, paragraphs 93-95, and page 17, paragraph 249, noted the follow-up on the debtor's account and generation of debtor's account report.); and

storing an indication of a result of the step of determining (Tracey: page 8, paragraph 141, and page 16, paragraphs 237 & 239, noted the history record).

With respect to **claim 2,** Tracey teaches the method of claim 1, wherein classifying the actions comprises classifying the actions as optimistically available (Tracey, Figures 12-13, page 17, paragraph 247).

With respect to **claim 3,** Tracey teaches the method of claim 2, wherein classifying the actions as optimistically available comprises classifying the actions as available subject to a rule (Tracey, page 6, paragraph 98 and page 18, paragraphs 264-266, noted the rule).

With respect to **claim 4,** Tracey teaches the method of claim 1, wherein the classifying the actions comprises classifying the actions as available according to a rule (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 5,** Tracey teaches the method of claim 1, wherein classifying the actions as available according to a rule comprises classifying the actions as being available only if the rule is complied with (Tracey, figures 22-23, and page 18, paragraphs 264-266).

With respect to **claim 6,** Tracey teaches the method of claim 1, wherein the classifying the actions comprises classifying the actions as universally available (Tracey, Figures 12-13, page 17, paragraph 247).

With respect to **claim 8,** Tracey teaches the method of claim 1, further comprising matching an application entity to the context entity (Tracey, page 12, paragraphs 182-183).

With respect to **claim 9,** Tracey teaches the method of claim 8, further comprising providing a view at an application of the actions available to be performed on each of the related service entities at the application services

(Tracey, fig. 8-10, page 15, paragraphs 219-225 and page 16, paragraphs 242-244).

In regard to **claim 10,** the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 10. By this rationale claim 10 is rejected.

With respect to **claim 11,** Tracey teaches the method of claim 10, comprising identifying that the associated context entity is derived from the first service entity and a second service entity at a second application service, the first service entity being related to the second service entity (Tracey, figures 1-3, page 8, paragraphs 141-142).

In regard to **claims 12-16**, the limitations of these claims are substantially the same as those in claims 2-6. Therefore the same rationale for rejecting claims 2-6 is used to reject claims 12-16. By this rationale claims 12-16 are rejected.

In regard to **claim 18**, the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 18. By this rationale claim 18 is rejected.

In regard to **claim 19**, the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 19. By this rationale claim 19 is rejected.

With respect to **claim 21,** Tracey teaches the system of claim 19, wherein said action service comprises a tracking mechanism to track performance of the first and the second actions (Tracey, abstract, pages 8-9, paragraph 142).

In regard to **claim 22**, the limitations of this claim are substantially the same as those in claim 8. Therefore the same rationale for rejecting claim 8 is used to reject claim 22. By this rationale claim 22 is rejected.

In regard to **claim 23**, the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 23. By this rationale claim 23 is rejected.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 7, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tracey et al. (PGPUB: US 2003/0083917 A1)** in view of **Brendle et al. (PGPUB: US 2005/0021355 A1).**

With respect to **claim 7,** Tracey teaches all the claimed limitations, except that he does not explicitly teach a method of determining if performance of the action will result in a conflict.

In the same field of endeavor, Brendle teaches a method of determining if performance of the action will result in a conflict (Brendle, page 11, paragraph 98, noted prevent locking of the actions result in conflict).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of determining result conflict as taught by Brendle in Tracey's invention in order to prevent locking and provide consistent result (Brendle, page 11, paragraph 98).

In regard to **claims 17 and 20**, the limitations of these claims are substantially the same as those in claim 7. Therefore the same rationale for rejecting claim 7 is used to reject claims 17 and 20. By this rationale claims 17 and 20 are rejected.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. L./

/Lin Liu/

Examiner, Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145